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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,173	12/21/2001	James Michael Larson	57411US002	2831

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EXAMINER

PARKER, FREDERICK JOHN

ART UNIT PAPER NUMBER

1762

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,173

Applicant(s)

LARSON, JAMES MICHAEL

A

Examiner

Frederick J. Parker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
4a) Of the above claim(s) 6-17 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Specification

The amendment in response to the Objection of informalities to the Specification of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the objection. The Examiner also withdraws the objections to the trademarks in view of Applicants' statement of recognition of trademarks used.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al US 4293396 in view of Fan et al US 2002/0134501.

The references are cited for the same reasons previously discussed, which are incorporated herein. Applicants' arguments have been fully considered.

Applicants argue the Examiner's position of the previous Office Action recognizing that while Fan does not specifically cite the limitation of compressing the coated carbon fiber cloth at 25% or greater, Fan expressly teaches rolling a coated carbon cloth "through two rolls with a certain pressure" (depending on thickness considerations) [0030]. Applicants argue that this does not "imply any compression at all". The Examiner strenuously disagrees. Application of pressure between two roller MUST cause at least some degree of compression to at least the surface of the coated cloth. Further, the reference states (and applicants repeat) that the rolling step is "to substantially eliminate cracks" to prevent shorting or break-down. Applicants arguments are therefore contradictory: the pressure exerted by the rollers is enough to remove cracks but not

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enough to cause ANY compression. The Examiner maintains compression MUST occur, even based upon Applicants own arguments; further, compression in Fan might occur at only the surface to eliminate cracks but Applicants are reminded their claims as written do NOT require anything else. The claims do Not require compression of 25 % or greater across the entire thickness. Compression does occur in Fan, and it is the Examiner's position that it would need to be at least 25 % to achieve the stated outcomes; it is incumbent upon the Applicants to supply evidence to the contrary, not mere conjecture, to persuade the Examiner otherwise. Thus, Applicants arguments on page 3- bridging 4 of Response are not convincing.

Applicants' first argument on page 4 is regarding shorting and thickness; such limitations are simply not in Applicants' claims. Although claims are read in light of the specification, this is different from reading limitations into a claim having no express basis in the claim in order to narrow the scope of that claim, In re Prater 162 USPQ 541. Such arguments are not further considered.

In response to the second argument on page 4 that Fan and the instant application do not share identical usage and outcome, the Examiner maintains both pertain to similar methods of forming gas diffusion layers for electrochemical cells comprising coatings applied to carbon cloth substrates and compressed to prevent leakage/ shorting (as admitted by Applicants to be a goal of their invention, page 4, line 9). Thus Applicants arguments are not persuasive.

The Examiner does not find the Applicants overall arguments persuasive and the rejections are maintained.

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2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

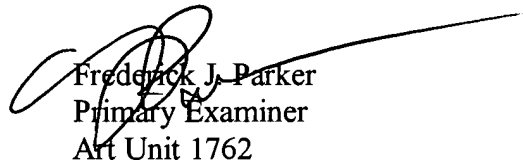
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 571/272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frederick J. Parker
Primary Examiner
Art Unit 1762

fjp